

REMARKS

Claims 1-16 are currently pending in the present application. By this Amendment claims 1 and 9 have been amended as set forth above. It is respectfully submitted that the pending claims define allowable subject matter.

In the outstanding Office Action, claims 1-4, 6-12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,424,996 (“Killcommons”) in view of United States Patent No. 5,649,185 (“Antognini”). Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Killcommons, Antognini and further in view of Computer Dictionary Third edition, Microsoft Press, 1997, ISBN 1-57231-446-X, p. 462. The Applicants respectfully traverse these rejections at least for the reasons discussed below, and already set forth during earlier prosecution of the present application.

I. The Combination Of Killcommons and Antognini Does Not Teach, Nor Suggest, Each And Every Limitation of Claim 1

The Applicants first turn to the rejection of claims 1-4, 6-12, and 14-16 under 35 U.S.C. 103(a) as being unpatentable over Killcommons and Antognini.

A. Requirements For A Prima Facie Case Of Obviousness

In order for a *prima facie* case of obviousness to be established, Section 2142 of the MPEP states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must

teach or suggest *all* the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness. See MPEP Section 2142 (“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”). The Applicants respectfully submit that the combination of references cited do not teach, nor suggest, each and every limitation of the claims, and, as such, a *prima facie* case of obviousness has not been established with respect to the rejection of the pending claims of the present application.

B. If Neither Killcommons And Antognini Teach A Limitation, Then The Combination Of The Two Also Does Not Teach The Limitation

Previous Office Actions admit that “Killcommons does not specifically teach storing first or second stored identification data on the server in response to the second identification data as provided by the first or second interface.” See, e.g., February 25, 2003 Office Action at pages 4-5, and July 15, 2003 Office Action at pages 4-5. As noted above, the combination of Killcommons and Antognini are used to reject claims 1-4, 6-12, and 14-16. Section 2142 of the Manual of Patent Examining Procedure (MPEP) dictates that in order for a *prima facie* case of obviousness to be established, the combination of these two references must teach or suggest all the claim limitations. Thus, if Antognini does not teach, nor suggest, the limitation as noted above, then the combination of Killcommons and Antognini, by definition, also cannot teach this limitation, because it has already been admitted that Killcommons does not teach it. As such, the Applicants will show that

Antognini does not teach, nor suggest, “storing first or second stored identification data on the server in response to the second identification data as provided by the first or second interface,” which previous Office Actions admit is not taught by Killcommons.

In order to clarify the scope of claim 1, the Applicants note that claim 1 has been amended to recite, in part, the following:

a single server located at the first location and connected to facilitate transfer of data between the first image storage unit and the second image storage unit through the network;

* * *

a first interface unit located at the first location and arranged to store first stored image data of the first patient on the first image storage unit in response to the first imaging data and to store first stored identification data on the server located at the first location in response to the first identification data;...

See claim 1 above.

Antognini “concerns electronic library services in which machine-executed processes manage collections of data representing books, papers, folder, personal files, and other informational media of durable value.” Antognini at Column 1, lines 13-16. Again, previous Office Actions admit that Killcommons does not teach “storing first or second stored identification data on the server in response to the second identification data as provided by the first or second interface.” Hence, if Antognini does not teach this limitation, then the combination of Killcommons and Antognini also does not teach this limitation.

C. Antognini Discloses A Separate Library Server At Each Library Location

Antognini uses a plurality of servers (e.g., library servers and object servers) to provide “access when a library user seeks to store, retrieve, or replace a data object in the library.” *See id.* at Column 2, lines 1-33. The purpose of Antognini is “to manage access to images which are stored

in a plurality of physically and geographically separate storage resources.” *Id.* at Column 3, lines 1-

3. Each server is a machine that includes a storage resource. Antognini defines a server as a machine including a storage resource.

Parenthetically, the inventors observe that the word “server” is often used ambiguously, even within a single reference. The term may denote *a machine including a storage resource* and several processes mediating access to the resource. Alternatively, it may denote one of those processes. In this description, the term “server” is used in the first sense, the word “process” being appended when the later is intended.

Id. at Column 4, lines 37-44 (emphasis added). As shown above, Antognini defines a server as a machine including a storage resource. Therefore, while Antognini may manage access to images in a plurality of physically geographically storage resources within a single location, each of those storage locations is part of a separate server. “Each ‘library server’ controls access to a single library at a time, maintaining data necessary to implement specified integrity, security and access conditions.” *Id.* at Column 3, lines 49-52. That is, each location uses its own separate servers. However, Antognini does not teach, nor suggest, a server that is common to separate locations.

The entire system of Antognini, as shown in Figure 1, is contained within a single location, namely a library. That is, unlike the claims of the present application, there is no first location, such as a hospital, and a second location, such as a clinic, that are remotely located from one another. The entire system of Antognini is contained within a single environment. The entire system of Antognini is contained within a single location, i.e., the library. In other words, while there may be a “first” location in Antognini, there is not a “second” location of which there is a “single” server used by both locations.

In Antognini, the users access the library server, etc., at a location that is proximate the library server. Antognini merely replaces the paper library with a digital library. However, Antognini does not teach, nor suggest, accessing information from a single server from remote locations. Rather, as discussed above, Antognini's libraries each have their own servers, but there is no central server common to a plurality of libraries.

D. Because Antognini Discloses Separate Library Servers For Separate Library Locations, Antognini Cannot Teach Storing First Or Second Stored Identification Data On A Server That Is Located In A First Location

The present Office Action notes that "Killcommons does not explicitly disclose storing first or second stored identification data on the server in response to the second identification data as provided by the first or second interface." Previous Office Actions admitted that Killcommons did not teach this limitation. As recited in claim 1, the second interface is located at the second location, which is separate and distinct from the first location, in which the server is located. In Antognini, the server, image servers, users, and the like are all located within the library, i.e., the first location. As such, Antognini cannot teach, nor suggest, storing first or second stored identification data on the server, which is located at a first location, in response to the second identification data as provided by the first or second interfaces, which are located at first and second locations, respectively. Previous Office Actions admit that Killcommons does not teach this limitation. Further, Antognini does not teach, nor suggest, this limitation because Antognini teaches a separate server for each library, i.e., location. Antognini does not teach, nor suggest, a single server common to multiple locations. Thus, Antognini cannot teach or suggest storing first or second stored identification data on a single server at a first location in response to second identification data as provided by the first or second interfaces, each of which are located at

separate locations. Because neither Killcommons, nor Antognini, teach this limitation, the combination of the two references together cannot, by definition, teach or suggest this limitation. Thus, at least for this reason, the Applicants respectfully submit that the combination of Killcommons and Antognini does not render claim 1 unpatentable.

At least for this reason, the Applicants respectfully submit that the pending claims of the present application should be in condition for allowance.

II. Traversal Of Perceived Assertion of Official Notice

As mentioned above, previous Office Actions admitted that Killcommons does not teach storing first or second stored identification data on the server in response to the second identification data as provided by the first or second interface. The present Office Action, however, seems to suggest that such a limitation is taught by Killcommons, despite the fact that it is not found within Killcommons. In particular, the Office Action states the following:

Although Killcommons does not explicitly disclose storing first or second stored identification data on the server in response to the second identification data as provided by the first or second interface, the Killcommons' invention image data would clearly include appropriate identification data that is input at the modality.

See July 14, 2003 Office Action at page 5.

This statement, because of the manner in which its is worded, could be interpreted as the Examiner asserting Official Notice of the subject of the statement. If the Examiner is asserting Official Notice that the subject of the statement is common knowledge, the Applicants respectfully traverse the Examiner's assertion as further set forth below. Alternatively, if the Examiner's assertion is based on the personal knowledge of the Examiner, then under MPEP §

2144.03(C) and 37 C.F.R. § 1.104(d)(2), the Examiner's assertion must be supported by an affidavit from the Examiner.

According to MPEP § 2144.03(A), Official Notice, without supporting references, should only be asserted when the subjects asserted to be common knowledge are "capable of instant and unquestionable demonstration as being well-known." That is, the subjects asserted must be of "notorious character" under MPEP § 2144.03(A).

However, the Applicant respectfully submit that the subject matter of the Examiner's assertion is not well-known in the art as evidenced by the searched and cited prior art. The Applicants respectfully submit that the Examiner has performed "a thorough search of the prior art," as part of the Examiner's obligation in examining the present application under MPEP § 904.02.

Additionally, the Applicants respectfully submit that the Examiner's searched and cited references found during the Examiner's thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner's thorough and detailed search of the relevant prior art, none of the prior art taught or suggested the subject matter of the Examiner's assertion. That is, the Examiner's thorough and detailed search of the prior art has failed to yield any mention of the teachings that the Examiner is asserting as widely known in the art. While the Office Action seems to suggest that Antognini discloses this limitation, the Applicants respectfully submit that Antognini does not teach, nor suggest, this limitation, at least for the reasons discussed above. The Applicants respectfully submit that if the subject matter of the Examiner's assertion had been of "notorious character" and "capable of instant and unquestionable demonstration as being well-known" under MPEP § 2144.03(A), then

the subject matter would have appeared to the Examiner during the Examiner's thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicants respectfully submit that the prior art does not teach the subject matter of the Examiner's assertion of Official Notice and respectfully traverse the Examiner's assertion of Official Notice.

The Applicants specifically challenge the following assertion:

Although Killcommons does not explicitly disclose storing first or second stored identification data on the server in response to the second identification data as provided by the first or second interface, the Killcommons' invention image data would clearly include appropriate identification data that is input at the modality.

The Applicants respectfully submit that the subject matter is not of such "notorious character" that it is "capable of instant and unquestionable demonstration as being well-known." Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support of the assertion of Official Notice if the Examiner intends to maintain any rejection based on the assertion. Additionally, the Applicants respectfully request the Examiner reconsider the assertion and provide any basis for the assertion. If the Examiner has any questions, the Examiner is invited and encouraged to contact the Applicant at the number below for further discussion.

III. The Remaining Claims Should Also Be In Condition For Allowance

With regard to the rejection of claim 9 being unpatentable over Killcommons and Antognini, Applicants respectfully submit that at least the same foregoing reasons set forth for claim 1 overcome the rejection and, therefore, the rejection should be removed.

With regard to the rejection of claims 2-4, 6-8, 10-12, and 14-16 being unpatentable over Killcommons and Antognini, Applicants respectfully submit that at least the same foregoing reasons set forth for claims 1 and 9 above overcome the rejection and, therefore, the rejection should be removed because claims 2-4 and 6-8 are dependent on claim 1, and claims 10-12 and 14-16 are dependent on claim 9.

With regard to the rejection of claims 5 and 13 being unpatentable over Killcommons and Antognini as applied to claim 4 and further in view of Computer Dictionary, Third edition, Microsoft Press, 1997, ISBN 1-57231-446-X, p. 462, Applicants respectfully submit that at least the same foregoing reasons set forth for claims 1 and 9 above overcome the rejection and, therefore, the rejection should be removed because claims 5 and 13 are dependent on claims 1 and 9, respectively.

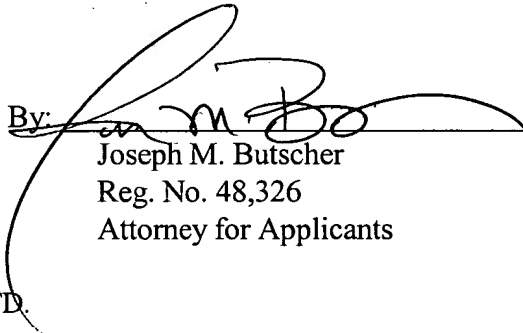
IV. Conclusion

In view of the foregoing, it is respectfully submitted that pending claims 1-16 of the present application define allowable subject matter. The Applicants respectfully request reconsideration of the claim rejections.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below. Please charge any additional fees or credit overpayment to Applicants' Deposit Account 07-0845.

Respectfully submitted,

Date: August 11, 2004

By: 
Joseph M. Butscher
Reg. No. 48,326
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775 - 8100